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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,953	03/28/2001	Paul Alan Stirpe	03433.00003	9620

22907 7590 10/03/2005

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EXAMINER

SMITH, TRACI L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/818,953	STIRPE ET AL.	
	Examiner	Art Unit	
	Traci L. Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

This action is in response to papers filed on July 5, 2005.

Claim 18 has been cancelled.

Claim 62 had been added.

Claims 1-17 and 19-62 are rejected.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-15, 19, 21-23, 25-50, 52-53, 55-58 and 60-62 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,151,584 Papierniak et al.

3. As to claims 1, 19, 31, 40-41, 47, 52, and 57 a system and method providing personalized content to a user comprising of storage, categorizing and grouped according to relatedness and analysis of data. ***Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions.*** (C.3 I. 20-25)

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4. As to claims 2-4, ***the data in the warehouse...usually subject-oriented such as customer, product, activity.*** (C. 14 I. 55-58)
5. As to claims 5, 28 and 37 ***formatted file library provides the intermediate classifications such as process characterizations, customer preferences, preference determination and behavior patterns.*** (C. 18 I. 45-48)
6. As to claims 6, 32-33, 43, 49 and 56, ***websmart is intend to provide the best possible knowledge for customers.*** (C. 18 I. 6-7)
7. As to claims 7, 9-10, 26-27 and 35-36 ***a display for displaying information to a computer user.*** (C. 10 I. 45-46, Fig. 4 Ref. 12)
8. As to claims 8, 25, 34, 42, 48, 55 and 58, ***involves parsing, categorizing, indexing and formatting the collected data.*** (C. 13 I. 17-18)
9. As to claims 11, 29 and 38 ***to collect data which indicates where a user has been in prior sessions.*** (C. 2 I. 65-66)
10. As to claim 12, ***Source data*** (Sheet 13 Fig. 13, bottom left corner)
11. As to claim 13 ***visitor profile data...depends on how much information the visited applications can entice the visitor to provide.*** (C. 15 I. 47-49)
12. As to claim 14, ***data mining tools enable the present invention to discover hidden knowledge from existing data and information.*** (18 I. 65-67)
13. As to claim 15, ***wherein the multiple client browsers or clients are capable of accessing a server or web server storing information.*** (C. 26 I. 49-50)

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14. As to claims 0, 39, 50 and 53, ***web warehouse is preferably time-stamped and associated with a defined period...subject oriented such as customer, product, activity.*** (C14. 56-61)

15. As to claims 21-23 ***metadata defines the data views necessary to produce the outputs required for decision support.*** (C. 15 I. 54-56)

16. As to claims 44-46, as best understood by the examiner, ***deletion of data in the web warehouse in an appropriate time.*** (C. 15 I. 65-67)

17. As to claims 60-61 Papierniak teaches ***a display for displaying information to a computer user.*** (C. 10 I. 45-46, Fig. 4 Ref. 12). Although Papierniak does not explicitly teach they information displayed as articles and advertisement these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information presented. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir.

18. As to claims 62 a system and method providing personalized content to a user comprising of storage, categorizing and grouped according to relatedness and analysis of data. ***Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions.*** (C.3 I. 20-25) , ***websmart is intend to provide the best possible knowledge for customers.*** (C.18 I. 6-7) ***a display for displaying***

information to a computer user. (C. 10 l. 45-46, Fig. 4 Ref. 12) **involves parsing, categorizing, indexing and formatting the collected data.** (C. 13 l. 17-18)

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 20, 24, 51, 54 and rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak et al as applied to claim 1-15, 18-19, 21-23, 25-50, 52-53 and 55-58 above, and further in view of Financialengines.com(any linkage Oct. 12, 1999).

21. As to claim 20, Papierniak fails to teach a step for drawing conclusions, financial engines.com teaches a **powerful simulation technology then forecasts what their actual investments might be.** (Pg. 23 l. 29-30). It would have been obvious to one skilled in the art to incorporate the conclusion process into Papierniak so as to give the customer useful information.

22. As to Claim 24, Papierniak fails to teach a display method for the of what the gathered information means. Financialengines.com teaches **how your decisions and advisor fund recommendations affect your future.**(P. 7 l. 4-7) See also Pg. 6 Fig. 2. It would have been obvious to one skilled in the art to incorporate the display method of

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financialengines.com to allow to the customer to see where they fit into the financial picture.

23. As to claims 51, 54 and 59, Papierniak fails to teach comparison method, financialengines.com teaches a ***retirement income projection is compared to your goal on a scenario by scenario basis***. (Pg. 17 l.6-7) It would have been obvious to one skilled in the art to incorporate the teachings of comparison into Papierniak so as to allow the customer the ability to make an accurate decision of one product over another.

24. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak et al as applied to claims 1-15, 18-19, 21-23, 25-50, 52-53 and 55-58 above, and further in view of Medscape.com(retrieved 7/9/04 any linkage February 29. 2000).

25. As to claims 16-17, Papierniak fails to teach display of related information. Medscapes.com ***medscape discloses a personal Medscape homepage from an assortment of specialty sites ...automatically delivers you to the site you specify or best fits your profile***. (Pg. 4 l. 3-9).

26. It would have been obvious to one skill in the art to incorporate the teachings of medscape into Papierniak to further personalize the system based on the users preferences as the basis of the invention.

Response to Arguments

27. Applicant's arguments, see Pg. 13-14, filed July 5, 2005, with respect to 35 USC 112 1st rejections have been fully considered and are persuasive. The 112 1st Paragraph rejecions of 1-17,19--51, and 60-61 have been withdrawn.

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28. Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive.

29. As to applicants arguments regarding "tagging data according to an ontology" examiner notes that the tagging is merely identifying data according to it's "group"; an ontology is merely using common terminology, therefore the classification or the grouping of things according to a common connection or similarities meets the limitation of tagging according to ontology. The examiner makes note of the applicants specification on PG. 16 I. 1-6 where a "classifier determines what ontology data belongs to and tags the data.(i.e. giving it a group with which it belongs.).

30. As to applicants arguments regarding 35 USC 103 rejections in that Papierniak fails to teach the initial limitations therefore the combination does not teach all the limitation. The examiner is not persuaded in that the examiner maintains assertion that Papierniak does meet the limitations as discussed before.

31. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both the primary reference and the secondary references are system and methods used for supporting customer decisions in an e-commerce environment, here in lies the motivation to

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combine, the secondary references of Financial Engines and Medscape are narrower customer decision modules used in a specific business arena and Papeirnak is broad customer decision module that would apply to all areas of e-commerce.

As to applicants arguments regarding the non-functional information of advertisements and articles of the system in claims 60-61 the functions of the **system/apparatus** or what the **system/apparatus** does, i.e. "wherein the data repository is accessible by the customer in order to determine a delivery status of the package, wherein the mobile communication unit automatically transmits the radiation signal to the gateway", these carry no patentable weight in an apparatus claim.

System/Apparatus claims should cover what a device is or structures or structural elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 572-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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